

ESTTA Tracking number: **ESTTA660625**

Filing date: **03/11/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	INFICON GmbH
Granted to Date of previous extension	03/11/2015
Address	Hintergasse 15B Bad Ragaz, CH-7310, SWITZERLAND
Attorney information	Jason S. Nardiello Hiscock & Barclay, LLP One Park Place, 300 South State Street Syracuse, NY 13202 UNITED STATES ip@hblaw.com, jnardiello@hblaw.com, ecominolli@hblaw.com Phone:3154252700

### Applicant Information

Application No	79123209	Publication date	11/11/2014
Opposition Filing Date	03/11/2015	Opposition Period Ends	03/11/2015
International Registration No.	1142834	International Registration Date	08/23/2012
Applicant	EVOTEK ENGINEERING SRL Via della Pace, 55/A I-41051 CASTELNUOVO RANGONE (MO), ITALY		

### Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Apparatus for transmission or reproduction of sound or images, stands for mobile telephones, covers for mobile telephones, stands for audio-video apparatus and mechanisms, blank magnetic data carriers, blank recording discs, blank compact discs, and DVDs; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, namely, electric and electronic apparatus and instruments for controlling the operation and driving of vehicles; onboard electronic components of vehicles, namely, computer hardware, central processing units, electrical controllers, multiplexers, electric switches, electronic display screens and structural parts thereof; onboard electronic components of vehicles, namely, electronic controls for internal combustion engines or electric motors for land vehicles; vehicle onboard electronic communications network systems comprised of computer hardware and software for the transmission of data; computer network interface devices; computer network interface devices for vehicle data networks and vehicle bus systems; computer hardware in the nature of computer mainframes for use in vehicles; computer hardware for use in managing data in vehicle data networks, namely, multiplexers and multiplexers with digital graphic display screens; central onboard

electronic controllers for vehicles; network routers for vehicles; electrical switches, namely, switch panels for vehicles; meters for measuring electricity; voltage regulators; voltage and amperage testers; cash registers, calculating machines, data processing apparatus, computers; computer software for use in the field of vehicle and engine design, controlling vehicle simulators, carbon fiber applications and acoustics, simulators for training of vehicles driving, simulators for driving and control of vehicles; fire-extinguishing apparatus

Class 012. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Vehicles, namely, land vehicles, custom vehicles, namely, land vehicles, electric vehicles, namely, land vehicles, parts of vehicles, namely, motors, electric controllers, kits and devices for converting endothermic engine vehicles into electric vehicles, electric motors for land vehicles; apparatus for locomotion by land, air or water, namely, land vehicles


Class 042. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Scientific and technological services, namely, research and design in the fields of vehicle design and construction, carbon fiber design and applications, acoustics, musical instrument restoration and energy savings; industrial analysis and research services in the fields of solutions to vehicle design and construction, acoustics, musical instrument restoration and energy savings problems; services of industrial design; services of industrial design for vehicles, driving simulators, stands for audio-video apparatus and mechanisms, stands for mobile telephones, design and development of hardware and software for carbon fiber applications, electronic controllers, acoustics, vehicle design and construction and design and construction of driving simulators

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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## Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2712579	Application Date	11/03/2000
Registration Date	05/06/2003	Foreign Priority Date	NONE
Word Mark	ECOTEC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1994/00/00 First Use In Commerce: 1994/00/00 GAS LEAK DETECTORS, GAS LEAK DETECTORS USING VACUUM FOR THEIR OPERATION		

Attachments	76158907#TMSN.png( bytes ) E EVOTEK ENGINEERING Notice of Opposition.pdf(179260 bytes ) Exhibit 1 - ECOTEC status.pdf(165786 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jason S. Nardiello/
Name	Jason S. Nardiello
Date	03/11/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Serial No. 79/123,209

**INFICON GmbH**

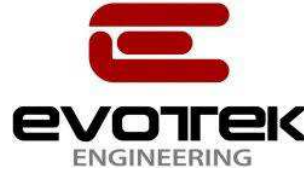
**Opposer,**

**v.**

**EVOTEK ENGINEERING SRL**

**Applicant.**

**Mark: E EVOTEK ENGINEERING (Stylized)**



**Opposition No. \_\_\_\_\_**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**NOTICE OF OPPOSITION**

INFICON GmbH, (hereinafter “Opposer” or “INFICON”) a foreign corporation organized and existing under the laws of the country of Switzerland, believes that it is or will be damaged by the registration of the mark E EVOTEK ENGINEERING (Stylized) shown in Serial No. 79/123,209, in International Class 9 for the goods identified therein (the “Application”), and hereby opposes same.

As grounds for the opposition, Opposer alleges the following:

**Opposer and Opposer’s Mark and Registration**

1. Opposer is a foreign corporation organized and existing under the laws of the country of Switzerland. Petitioner’s address Hintergasse 15B, Bad Ragaz, CH-7310, Switzerland.
2. INFICON is a leading researcher, developer, manufacturer and seller of innovative scientific and industrial instruments that are utilized by end-users across many industries.

INFICON's products are largely grouped into vacuum-based processes and leak detection solutions. Many industries rely on these instruments. For example, the client's leak detector products alone, which are only a portion of the total products offered and sold by INFICON, are used in a far-reaching array of industries. These industries include Specific Vacuum Process industries such as the semiconductor manufacturing, optics, and solar panels industries. INFICON's leak detectors are also used in the Emergency Response and Security industries, specifically, for military applications, alternative energy and petro chemical, and in the public utilities sector. In the Refrigeration and Air Conditioning Industries, the leak detectors are sold for a wide range of applications, including, refrigeration, air conditioning, automotive, and automotive service tools.

Since at least as early as 1994 and, since before Applicant, Evotek Engineering SRL's ("Applicant") first use (whether actual or constructive) of the mark shown in the E EVOTEK ENGINEERING Application, INFICON has continuously used and presently uses the mark, ECOTEC (standard characters), U.S. trademark Reg. No. 2,712,579 in interstate commerce throughout the United States in connection with the distribution and sale of its leak detector products.

3. INFICON's ECOTEC Reg. No. 4,065,589 is registered for "Gas leak detectors, gas leak detectors using vacuum for their operation" in Class 9.

4. Pursuant to 37 CFR § 2.122(d)(1), current printouts of information from the electronic database of records of the USPTO showing the current status and title of the ECOTEC Registration is attached as **Exhibit 1**. As is evident from the document presented in Exhibit 1, INFICON's Registration is valid, subsisting, and is in full force and effect.

5. As a result of INFICON's use in commerce of the ECOTEC Mark, the Mark is symbolic of the extensive goodwill and consumer recognition established by INFICON. The ECOTEC Mark identifies and distinguishes INFICON's leak detector products and operates as an identifier of source. Specifically, when prospective purchasers of INFICON's goods encounter the

ECOTEC mark in the marketplace, they understand that the goods associate therewith emanate from a single source. That source is INFICON.

### **Applicant and Applicant's Mark**

6. Applicant is, upon information and belief, a foreign limited company organized under the laws of Italy, having an address of Via della Pace, 55/A, I-41051 Castel Nuovo Rangone (MO), Italy.

7. On January 10, 2013, Applicant applied for the E EVOTEK ENGINEERING (stylized) mark under Serial No. 79/123,209 for “Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media, stands for mobile telephones, covers for mobile telephones, stands for audio-video apparatus and mechanisms, coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software, simulators for training of vehicles driving, simulators for drive and control of vehicles; fire-extinguishing” in Class 9; “Vehicles, custom vehicles, electric vehicles, parts of vehicles, electric motors for land vehicles, apparatus for locomotion by land, air or water” in Class 12; and “Scientific and technological services and research and design relating thereto; industrial analysis and research services; services of industrial design, services of industrial design for vehicles, driving simulators, stands for audio-video apparatus and mechanisms, stands for mobile telephones, design and development of hardware and software” in class 42.

8. The E EVOTEK ENGINEERING application utilized a filing basis under § 66A of the Trademark Act (Madrid Protocol), by which Applicant seeks to register the mark in the aforementioned classes. The application makes a priority claim of August 22, 2012.

## **GROUND**

### **Likelihood of Confusion**

9. INFICON repeats and realleges each and every allegation set forth in Paragraphs 1 through 8 above, as if fully set forth herein.

10. Applicant's E EVOTEK ENGINEERING Mark, as shown in the Application, is confusingly similar in sight, sound, and meaning to INFICON's previously registered and used ECOTEC mark.

11. The connotation and overall commercial impression of the E EVOTEK ENGINEERING Mark is confusingly similar to that of the INFICON's ECOTEC Mark in that both utilize the formative "TEK" as a suffix and the terms ECO and EVO sound similar. Under certain commercial settings, the prefixes can impart the same meaning. Overall, the marks provide the same connotation.

12. The goods identified in the E EVOTEK ENGINEERING Application are highly related to or are identical to the goods on which the ECOTEC Mark is used and registered.

13. Applicant's E EVOTEK ENGINEERING Mark, when used in connection with the goods identified in the Application, so resembles the senior ECOTEC Mark as to be likely to cause confusion, to cause mistake, and/or to deceive members of the purchasing public concerning a sponsorship or endorsement of, or an affiliation, connection or association with the source of goods sold under the ECOTEC Mark, all in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and with consequent injury to INFICON and the trade.

14. Pursuant to Section 13(a) of the Lanham Act, 15 U.S.C. § 1063(a), INFICON believes it will be damaged by registration of Applicant's E EVOTEK ENGINEERING Mark in that members of the purchasing public and/or the relevant trade are likely to be confused or mistaken that Applicant's goods and services offered under its E EVOTEK ENGINEERING Mark originate from

INFICON, or from the same source as goods sold under INFICON's ECOTEC Mark, or that such goods of Applicant are sponsored by, endorsed by, or affiliated with the source of goods sold under the ECOTEC Mark. Such likelihood of confusion results in damage to the goodwill among purchasers and the trade that INFICON's ECOTEC symbolizes. Registration of Applicant's E EVOTEK ENGINEERING mark will support and assist Applicant in the confusing and misleading use of Applicant's E EVOTEK ENGINEERING, and, in addition, will give color and exclusive statutory right to Applicant in violation and in derogation of the prior and superior rights of INFICON.

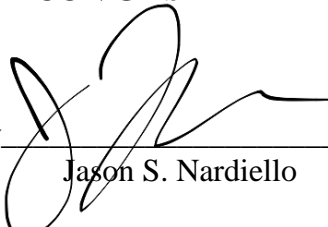
**Relief Requested**

**WHEREFORE**, INFICON respectfully requests that registration of Applicant's E EVOTEK ENGINEERING Mark, as shown in the Application, be refused.

Please recognize Jason S. Nardiello and the law firm of Hiscock & Barclay, LLP as attorneys for Petitioner in connection with this opposition proceeding. Please address all correspondence regarding this proceeding to Jason S. Nardiello at Hiscock & Barclay, LLP, 300 South State Street, Syracuse, New York 13202.

Respectfully submitted,

**INFICON GmbH**

By  \_\_\_\_\_  
Jason S. Nardiello

**HISCOCK & BARCLAY, LLP**  
300 South State Street  
Syracuse, New York 13202  
Tel. No.:(315) 425-2831

Dated: Syracuse, New York  
March 11, 2014



Fax No.: (315) 703-7367

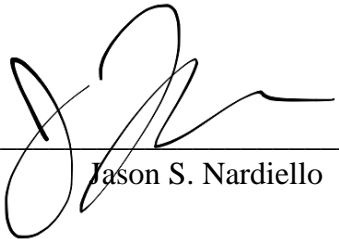
E-Mail: [jnardiello@hblaw.com](mailto:jnardiello@hblaw.com),  
[ip@hblaw.com](mailto:ip@hblaw.com)

*Attorneys for Opposer, INFICON, GmbH*

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing "NOTICE OF OPPOSITION" was served on the correspondence of record, Dennis H. Cavanaugh, D H Cavanaugh Associates, 555 5<sup>th</sup> Avenue, Fl. 17, New York, New York 10017-9254, by depositing a true copy of the same with the United States Postal Service as first-class mail, postage prepaid, and by email to [dhc@dcavanaugh.net](mailto:dhc@dcavanaugh.net) on this the 11th day of March, 2015.

Dated: March 11, 2015

  
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Jason S. Nardiello



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<b>Word Mark</b>	ECOTEC
<b>Goods and Services</b>	IC 009. US 021 023 026 036 038. G & S: GAS LEAK DETECTORS, GAS LEAK DETECTORS USING VACUUM FOR THEIR OPERATION. FIRST USE: 19940000. FIRST USE IN COMMERCE: 19940000
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	76158907
<b>Filing Date</b>	November 3, 2000
<b>Current Basis</b>	1A;44E
<b>Original Filing Basis</b>	1B;44D
<b>Published for Opposition</b>	February 11, 2003
<b>Registration Number</b>	<b>2712579</b>
<b>Registration Date</b>	May 6, 2003
<b>Owner</b>	(REGISTRANT) INFICON GMBH CORPORATION SWITZERLAND HINTERGASSE 15 B CH-7310 BAD RAGAZ SWITZERLAND
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	Jessica R. Murray, Esq.
<b>Priority Date</b>	May 3, 2000

**Prior Registrations** 1912306  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130325.  
**Renewal** 1ST RENEWAL 20130325  
**Live/Dead Indicator** LIVE

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